

Questions and Answers
regarding the
GATT Uruguay Round
and
NAFTA Changes
to
U.S. Patent Law and Practice

United States Patent and Trademark Office
February 23, 1995

PLEASE NOTE: The responses provided herein are consistent with Patent and Trademark Office plans for implementation of the Uruguay Round Agreements Act as of February 22, 1995. As rulemaking proceeds for the twenty year term and provisional application provisions of the Act, responses to some questions may change. Accordingly, the final rule package for the implementation of the twenty year term and provisional application provisions should be consulted for additional guidance.

General Questions

1. What increase in patent application filings due to the law changes does the Patent and Trademark Office (PTO) anticipate before June 8, 1995, and what effect will the increase have on pendency?

Ans.: The PTO is committed to taking all possible measures to reduce pendency to maximize resultant patent terms in a system in which the end of a patent term is measured from the filing date of a given application, taking into account any reference to an earlier filing date under 35 U.S.C. §§ 120, 121 or 365(c).

The PTO has not made any numerical estimates of increases in filings or the anticipated increase in pendency, if any, as a result of implementing the Uruguay Round Agreements Act. However, 28% of our application filings are continuing applications, i.e., continuations, continuations-in-part or divisional applications. We anticipate that a large percentage of the continuing applications that would have been filed in the year after June 8, 1995, will be filed prior to June 8, 1995. This should be followed, however, by a significant and perhaps proportionate drop in the filing of continuing applications after June 8, 1995.

In addition, some of the applications that would have been filed after June 8, 1995 will probably now be filed as provisional applications that will not be subject to examination. So, while we expect an increase in the number of applications filed before June 8, 1995, it will likely be followed by a proportionate decrease in the filing of applications that are subject to examination, so that there is not likely to be a significant increase in pendency because of the increase in filings prior to June 8, 1995.

It is difficult to assess the impact on overall pendency due to the transitional after-final and restriction practices.

2. What is the target date for the final rules?

Ans.: Since the final rules will involve setting new fees, we are required to publish the final rules in both the *Official Gazette* and the *Federal Register* thirty days in advance of putting these fees into effect. Accordingly, the final rules will be published before May 8, 1995.

3. Will the standards for restriction practice change when the 20-year patent term becomes effective?

Ans.: Other than the transition restriction practice that has been adopted, there are no plans to change current restriction practice. The PTO has been urged, from time to time, to adopt a unity of invention practice similar to that employed in PCT applications. However, no work has been done on how fees would need to be adjusted to permit additional resources to be devoted to a single application. A change in restriction practice along the lines of the PCT unity

of invention practice, without changes to the fee schedule, would have a negative impact on fee income.

4. Will topics related to these new laws be on the exam for registration to practice before the PTO in May, 1995?

Ans.: No, the subject matter will not be on the exam for about two years. However, anyone preparing to practice before the PTO in the future should familiarize themselves with both the new laws and the new procedures that will go into effect on June 8, 1995.

5. Will the United States adopt a first-to-file system soon?

Ans.: The United States is not prepared, at this time, to continue negotiations on the issue of patent law harmonization and the adoption of a first-to-file system. The GATT Uruguay Round implementing legislation does not require the adoption of a first-to-file system.

6. Will these "Questions and Answers" and other relevant information, including the slide presentation on "The Effects of GATT and NAFTA on PTO Practice," be put on the Internet?

Ans.: Yes.

35 U.S.C. § 104 Changes - Proving Dates of Invention in Foreign Countries

1. What are the NAFTA countries?

Ans.: Canada and Mexico.

2. What are the World Trade Organization (WTO) member countries?

Ans.: The WTO member countries are those countries that are signatories to the World Trade Organization Agreement. As of January 1, 1995, the following countries were WTO member countries:

Antigua and Barbuda	Argentina	Australia
Austria	Bahrain	Bangladesh
Barbados	Belgium	Belize
Botswana	Brazil	Brunei Darussalam
Canada	Chile	Colombia
Costa Rica	Cote d'Ivoire	Czech Republic
Denmark	Dominica	European Communities
Finland	France	Gabon
Germany	Ghana	Greece
Guyana	Honduras	Hong Kong
Hungary	Iceland	India
Indonesia	Ireland	Italy
Japan	Kenya	Korea
Kuwait	Lesotho	Luxembourg
Macau	Malaysia	Malta
Mauritania	Mauritius	Mexico
Morocco	Myanmar	Namibia
Netherlands	New Zealand	Nigeria
Norway	Pakistan	Paraguay
Peru	Philippines	Portugal
Romania	St. Lucia	St. Vincent and the Grenadines
Senegal	Singapore	Slovak Republic
South Africa	Spain	Sri Lanka
Suriname	Swaziland	Sweden
Tanzania	Thailand	Uganda
United Kingdom	United States	Uruguay
Venezuela	Zambia	

Information regarding WTO member countries can be obtained by calling the Office of Legislative and International Affairs at (703) 305-9300.

3. What is the effective date of the WTO Agreement?

Ans.: The WTO Agreement came into force January 1, 1995.

4. When can a Canadian applicant establish a date of invention in Canada in an interference proceeding?

Ans.: A date of invention in Canada cannot be established prior to December 8, 1993. For applications filed on or after December 8, 1993, dates of invention can be proven by

reference to activities in Canada. However, December 8, 1993, is the earliest such date that can be proven.

5. Can a date of invention be established in a NAFTA or WTO member country in a patent issued before the NAFTA or GATT implementing legislation became effective? What about in a patent issued after the effective date on an application that was filed before the NAFTA or GATT implementing legislation became effective?

Ans.: No. The effective date of the relevant provisions is December 8, 1993, for NAFTA countries, and January 1, 1996 for WTO member countries.

6. What is the earliest date that a person could establish as a date of invention in a NAFTA country?

Ans.: December 8, 1993

In a WTO member country?

Ans.: January 1, 1996.

7. Can an applicant in a patent application or patentee in a reexamination proceeding establish a date of invention in a NAFTA or WTO member country to overcome a printed publication or a patent that discloses but does not claim the same invention?

Ans.: Yes, 37 CFR 1.131 will have been amended to parallel the changes that were made to 35 U.S.C. § 104.

8. What is the earliest date that an inventor can use to establish a date of invention in a NAFTA or WTO member country to overcome a patent or printed publication?

Ans.: The earliest date that an inventor can use to establish a date of invention in a NAFTA or WTO member country is December 8, 1993, in a NAFTA country, and January 1, 1996, in a WTO member country.

9. What type of showing is required to establish a date of invention in a NAFTA or WTO member country?

Ans.: A proposed change to the interference rules has been published to implement the changes required by the NAFTA change to § 104. Guidance will be published for changes required by GATT. Guidance will also be published for affidavit practice under 37 CFR 1.131.

10. Would a foreign inventor be able to establish a date of invention in a NAFTA or WTO member country to defeat an opponent in an interference even though the foreign inventor suppressed or concealed the invention?

Ans.: Yes. If a foreign inventor is able to win the interference, even though the invention was suppressed or concealed, the opponent would be precluded from obtaining a patent under the doctrine of interference estoppel.

11. Can an inventor who has made an invention in a NAFTA or WTO member country, but is not a citizen of that country rely on the dates of invention in the NAFTA or WTO member country for the purpose of obtaining a patent in the U.S.?

Ans.: Yes.

12. Will the PTO propose rules and provide guidance in the Manual of Patent Examining Procedure (MPEP) to establish a date of invention in a foreign country?

Ans.: Yes, interference rules relating to establishing a date of invention in a NAFTA country have been published. The MPEP will be revised to reflect both the NAFTA and GATT changes.

13. Will it be more difficult to establish a date of invention in this or in a NAFTA or WTO member country?

Ans.: It may be more difficult to establish a date of invention in a NAFTA or WTO member country than it is in this country. To the extent that information proving or disproving a date of invention is not made available in a proceeding in the Patent and Trademark Office, a court, or any other competent authority, to the same extent as such information could be made available in the United States, the Commissioner, court or other authority is to draw appropriate inferences in favor of the party requesting the information. Accordingly, the attempt to establish a date of invention in other countries may be adversely affected by this provision.

14. Will interferences with foreign applicants be more complex and costly for U.S. inventors, and will U.S. inventors face an increased risk of losing such an interference?

Ans.: The cost and complexity may increase due to the problems associated with obtaining evidence related to inventive activity outside the United States, and the risk of losing may increase because inventors from a NAFTA or WTO member country are no longer limited to acts associated with the filing dates of their foreign priority applications.

15. Are the patent defeating provisions of
§ 102(a) [. . . invention was known or used by others in this country];
§ 102(b) [. . . in public use or on sale in this country]; or
§ 102(g) [. . . the invention was made in this country];
affected by the GATT implementing legislation?

Ans.: No.

16. If one disagrees with the PTO on the need for changes to the sections of title 35 cited in the preceding question, what are the options?

Ans.: An individual may seek a legislative change as with any provision of the patent laws. However, an individual has no standing to raise matters before the WTO as there is no individual standing before the WTO.

17. Can an applicant use pre-January 1, 1996 information to prove a date of invention of January 1, 1996 in a WTO member country?

Ans.: Yes.

18. In an interference, if two applicants have January 1, 1996 dates, who wins?

Ans.: The result in this situation is not affected by the Uruguay Round Agreements Act. Three relevant decisions are: Wood v. Eames, 1880 C.D. 106 (Comm'r Pat. 1880); Lassman v. Brossi et al., 1968 C.D. 102 (Bd. of Int. 1967), 855 O.G. 12 (Decided October 26, 1967) and Oka v. Youssefyeh, 7 USPQ2d 1169 (Fed. Cir. 1988).

19. If an application and a patent in an interference both have January 1, 1996 dates, who wins?

Ans.: See the response to the previous question. Again, the result in this situation is not affected by the Uruguay Round Agreements Act.

20. If a country joins the WTO after January 1, 1996, what is the effective date for proving inventive activity in that country for the purpose of § 104 and 37 CFR 1.131?

Ans.: The effective date for proving inventive activity in that country is the date the country becomes a member of the WTO. This is the date the agreement relationship, and the benefits flowing therefrom, between the newly joining country and the WTO membership comes into being. This same rationale has been applied to the effective dates for joining the Patent Cooperation Treaty and the Paris Convention.

20-Year Patent Term

1. When is the 20-year patent term legislation effective?

Ans.: June 8, 1995

2. Will continuing applications be subject to the 20-year patent term after June 8, 1995?

Ans.: Yes, every application filed on or after that date will be subject to the 20-year patent term. However, the 20-year patent term will not apply to the entry into the national stage under 35 U.S.C. § 371 on or after June 8, 1995 based upon an international application designating the United States filed prior to that date. For PCT applications, the international filing date is the determinative date except when it is used as prescribed in 35 U.S.C. § 365(a).

3. Does an applicant have to claim the benefit of an earlier filed application? Can you adjust the start of the period of the 20 -year patent term by not claiming the benefit of a parent application?

Ans.: An applicant has full control over claims to the benefit of an earlier filing date under 35 U.S.C. §§ 120, 121 or 365(c). The 20-year term will be based upon the filing date of the earliest U.S. application that the applicant makes reference to under 35 U.S.C. §§ 120, 121 and 365(c). Whether an applicant is entitled to the benefit of the filing date of an earlier application is something that an applicant should examine before the patent is issued. The office is not, unless it comes up as an issue in the examination process, going to determine whether any of the claims are entitled to the earlier filing date. Applicant however should determine whether the claims that are about to issue are entitled to or require the benefit of the earlier filing date. If not, the applicant should consider not claiming the benefit of the earlier filing date to avoid having the 20-year patent term measured from that earlier filing date. An amendment adding or deleting a reference to an earlier filed application must be presented in a timely manner, e.g., prior to a final rejection.

4. Can a patentee disclaim/claim the benefit of the filing date of an earlier filed application after the patent issues?

Ans.: Yes, so long as the conditions of 35 U.S.C. § 251 are satisfied. Note that a disclaimer will not, however, operate to extend the term of a patent as the term of a reissued patent is limited by the unexpired term of the original patent.

5. If a patent loses the benefit of an earlier filing date under 35 U.S.C. §§ 120, 121 or 365(c) as a result of litigation, is the 20-year from filing term of the patent automatically extended because the effective filing date of the application becomes later in time?

Ans.: No, the 20-year from filing term maximum is fixed as of the grant of the patent. The fact that the grant includes a claim for the benefit of an earlier filed application by making reference to 35 U.S.C. §§ 120, 121 and/or 365(c) is determinative. Whether an application/patent is entitled to, or subsequently loses, such a claim is not relevant to the term issue.

6. Will the term of a patent granted on an application that relies on one or more parent applications be based on a claim-by-claim approach or based on the filing date of the earliest application?

Ans.: The term will be based on the filing date of the earliest application. Applicant should review whether any claim in the patent that will issue is supported in earlier applications. If not, applicant should consider whether to claim the benefit of an earlier filing date. However,

since the deletion of a reference to an earlier application potentially creates a new body of prior art that would be applicable against the claimed invention, it is unlikely that the Office would permit that type of amendment unless timely presented, i.e., before a final Office action.

7. Is the 20-year patent term measured from the filing of a provisional application?

Ans.: No, § 154(a)(3) provides that priority under § 119 is not taken into account in determining the term of a patent. The basis for relying upon a provisional application in a subsequently filed § 111(a) application is § 119(e).

8. Is the 20-year patent term measured from the filing of a PCT international application designating the United States.?

Ans.: Yes, the international filing date in an international application designating the United States will start the 20-year patent term. If an international application claims the benefit of a previously filed § 111(a) application, the 20-year patent term would be measured from the filing date of the § 111(a) application, or unless the international application designating at least one country other than the United States is used as a foreign priority application under 35 U.S.C. 365(a).

9. Is the 20-year patent term applicable to design patents?

Ans.: No, the 20-year patent term is only applicable to utility and plant patents. Design patents will continue to have a term of fourteen years from grant.

10. Will the timetable for paying maintenance fees change under the 20-year patent term?

Ans.: No. Maintenance fees will continue to be due at 3.5, 7.5 and 11.5 years from the patent issue date.

11. Does a patentee receive any enforceable rights before a patent is granted under the 20-year patent term?

Ans.: No. Under 35 U.S.C. § 154(a)(2) the term begins on the date on which the patent issues. The endpoint of the term is then measured 20 years from the date on which the application for patent was filed, taking into account all claims for the benefit of earlier filing dates made under 35 U.S.C. §§ 120, 121 and 365(c), but excluding claims under 35 U.S.C. § 119. The enforceable life of a patent also includes the six year statute of limitation, set forth in 35 U.S.C. § 286

12. Will the 20-year patent term make filing under the PCT less attractive?

Ans.: The decision to use the PCT may depend on the particular industry and type of invention for which patent protection is sought. For those types of inventions, particularly in the regulated industries where a product is not placed on the market for some period of time after initial filing, filing under the PCT coupled with a provisional application could be even more attractive than it is now. On the other hand, if the invention is in a fast moving industry where a patent is valuable immediately but not in its later years, filing under the PCT is probably not attractive now, nor would it be under the 20-year patent term.

13. While the average pendency for all applications is ~19.0 months, what is the average pendency for the biotechnology area?

Ans.: The average pendency for the biotechnology Group 1800 at the end of fiscal year 1994 was approximately 21.0 months from filing to final disposition. This number is the average pendency per application and does not address how long a given invention may be pending before the Office from initial filing to final disposition where a series of related applications may be filed.

14. Will delays on the part of the PTO other than those encountered in appeals, interferences, or the placement of secrecy orders be the basis for administrative patent term extensions?

Ans.: No

15. Will the office print on the face of the patent the length of any administrative patent term extension that was granted with respect to any particular patent?

Ans.: Yes, our current plans are to make a determination and inform applicant of the length of patent term extension at the time of mailing the notice of allowance and issue fee due. If applicant disagrees with our interpretation, it can be addressed by way of 37 CFR 1.181 petition. The length of the extension will be printed on the face of the patent in the same location that terminal disclaimer information currently appears.

16. There is an attempt in Congress to change the 20-year patent term in the GATT legislation to provide for a patent term that is the longer of 17 or 20 years for all future patents. Is it true that the Clinton administration has agreed not to oppose this proposed change?

Ans.: The administration strongly believes that the 20-year patent term as enacted in the Uruguay Round Agreements Act is the appropriate way to implement the 20-year patent term. It is the only effective way to combat the substantial economic harm that is caused by submarine patents - patents that issue in a mature industry after substantial and intentional delay in the Office.

17. Once the 20-year patent term is in effect, will it still be necessary to file a terminal disclaimer in an obviousness-type double patenting situation where the two involved patents will expire on the same date?

Ans.: Yes, in an obviousness-type double patenting situation, there are two problems that a terminal disclaimer addresses. The first, that the terms of the two patents end on the same date, would be taken care of by the 20-year patent term if one of the applications claims 35 U.S.C. §§ 120, 121 or 365(c) benefit of the other. The second problem is one of common ownership in that our current rules (37 CFR 1.321(c)) specify that the patent shall be enforceable only for and during such period that the patents are commonly owned. The 20-year term, *per se*, would not address this latter concern. Accordingly, some paper should be submitted that addresses the concern of common ownership.

18. Will the PTO publish expiration dates on patents?

Ans.: No. The term of patent will be readily discernible from the face of the patent. The PTO will publish on the face of the patent any term extension that is granted as the result of administrative delay in issuing the patent. This information is likely to appear in the location where the terminal disclaimer information now appears. Our plans to date do not call for printing the expiration date on the face of the patent. First, the 20-year term affects patents in force on June 8, 1995, and would cover some patents issued in 1978 and thereafter. It would be a significant burden to recalculate the patent term and print a certificate of correction on 17 years of patents. Second, the term of a patent is dependent on the timely payment of maintenance fees which are not printed on the face of a patent. Third, the patent term will be apparent, to a

knowledgeable reader, from the face of a patent. The PTO's efforts will focus on educating the public on how to determine the expiration date of a patent.

19. Is an action under 35 U.S.C. § 146 in district court considered to constitute "appellate review" for the purpose of making a patent eligible for patent term extension because of delays encountered in successful appellate review?

Ans.: No, actions under 35 U.S.C. § 146 would be taken into consideration as a delay for interference purposes.

20. Why is extension for secrecy order delays limited to 5 years?

Ans.: Our principal guidance on this issue came from the 1992 Report on the Advisory Commission on Patent Law Reform, conducted by the previous Administration. In that report, a five year patent term extension was recommended for secrecy order delays.

21. Is the PTO considering any change to its petition to make special practice, to afford applicants an opportunity to accelerate examination?

Ans.: No. The PTO has great flexibility in this area, but cannot afford to accelerate the prosecution of a large number of applications without also delaying the prosecution of the remainder.

22. What is being done to accelerate the appeal process within the PTO?

Ans.: The PTO plans to add additional staff to the Board in the future.

23. Will the PTO take a more liberal view toward the granting of interviews, particularly with respect to applications that are pending on June 7, 1995?

Ans.: The PTO has already taken steps to encourage examiners to conduct interviews by granting the examiner additional time when engaged in that activity. Examiners are encouraged to conduct interviews whenever the prosecution can be advanced.

24. What should applicants do on or around the effective date with regard to the filing of new, first-filed applications?

Ans.: To preserve the option to obtain a 17-year patent term, one must file prior to June 8, 1995. However, not all applications in all technologies will have to be filed prior to that date to maximize term. In those technical areas where pendency is fairly low, the rush to file prior to the effective date may be unwarranted because a 20-year term from filing may result in a longer patent term than the current term of 17 years from grant. There is another issue that comes into play for filing strategies. For those products, the market life of which is fairly short, obtaining a 17 or 20-year patent term may be irrelevant and for patent applications in those technical areas where the market life of a given product is indeed short, the rush to file prior to June 8, 1995 may be misplaced. Current maintenance fee statistics also indicate that, for many patentees, obtaining a 17-year term from grant or a 20-year grant from filing will not be a great concern. The first maintenance fee is paid in about 80% of patents, the second maintenance fee is paid in about 57% of patents and the third maintenance fee is paid in only about 25% of patents. (Source of maintenance fee payment data: Notice of Proposed Rulemaking on Revision of Patent Fees at 59 FR 27520, May 27, 1994.)

Applicants should also examine the possibility of filing provisional applications under 35 U.S.C. § 111(b) as of June 8, 1995. The filing of a provisional application, followed within one year by the filing of an application in accordance with 35 U.S.C. § 111(a), will provide an

applicant with a term the end date of which is measured 21 years from the provisional application filing date. In such a scenario, the term does not start to run until the filing of the 35 U.S.C. § 111(a) application. An applicant could also file a 35 U.S.C. § 111(a) application and within twelve months of its filing date convert it to a provisional application and file another 35 U.S.C. § 111(a) application to delay the running of the term until the filing of the second 35 U.S.C. § 111(a) application.

25. Does the successful appellate review extension apply to the situation where the appellate is less than fully successful, e.g., if only one claim is ultimately allowed?

Ans.: Yes.

26. If a patent with a term measured from the filing date expires prior to the time the last maintenance fee is due, must the fee be paid?

Ans.: No.

27. What is the effect of filing a reissue application on the term of a patent that was subject to extensions under 35 U.S.C. § 154(b) or 35 U.S.C. § 154(c)?

Ans.: If extensions are granted under 35 U.S.C. § 154(b) the original term of the patent would include the extension. The term of the reissue would be the unexpired portion of that term. With regard to 35 U.S.C. § 154(c), because that portion of the statute operates automatically, the term of the underlying patent is automatically the longer of the 17-year term or the 20-year term and the term of the reissued patent would be the unexpired portion of the term reflecting the automatic operation of the 17/20 provision.

28. Can a continuation that is filed and granted after the effective date of the term provisions obtain term extension for an interference in a parent application filed prior to the effective date?

Ans.: The extension provisions in 35 U.S.C. § 154(b) are only applicable to applications filed on or after June 8, 1995. Accordingly, interferences, secrecy orders or successful appellate reviews conducted in applications filed prior to the effective date cannot serve as the basis for extensions in patents granted on applications filed after the effective date.

If both a parent application and a continuing application are filed after the effective date and there was a delay in the parent application that contributed to a delay in the issuance of a patent in the continuing application, the patent granted on the continuing application may be eligible for an extension under 35 U.S.C. § 154(b).

29. Can patent term extension for suspension of prosecution in a given application due to an interference declared in other applications be obtained?

Ans.: Yes.

30. Will examiners be briefed/trained on the GATT changes?

Ans.: The appropriate training will be given to all examiners.

31. Do appeal extensions cover the situation where a notice of appeal and brief are filed and then the examiner changes position and allows the application to issue as a patent?

Ans.: No.

32. Did the PTO consider the malpractice implications of the "due diligence" standard established for successful appellate review extensions.

Ans.: The application of the due diligence standard will be subject to rebuttal by an attorney in a given application.

33. Under the 20-year term scheme, will examiners be encouraged or required to make all appropriate restriction requirements early in the pendency of a given application?

Ans.: Yes, current practice dictates that restriction requirements be made at the earliest appropriate time in the pendency of a given application, e.g., in the first Office action.

34. How will the extension provision for successful appellate review operate in an application where (1) certain claims are indicated as being allowable and others are successfully appealed to the Board or the Courts; and (2) certain claims are won at the Board and then other claims are won at the federal Court level?

Ans.: The extension provision is not claim-specific and is applicable to the last claim won in the appeal process and the resultant extension would be applicable to all claims in a given, ultimately granted patent.

35. Does the PTO have plans to increase the size of the examining corps to expedite examination?

Ans.: To the extent that increases in the examining corps are made available to the PTO, examiners will be hired .

36. Will the language that the PTO puts on the front page of the patents regarding terminal disclaimers change?

Ans.: A change in the printed terminal disclaimer language is under consideration.

37. If a patent expires for failure to pay a maintenance fee, what happens to a patent that refers to the expired patent in a terminal disclaimer.

Ans.: The GATT Uruguay Round changes do not require any changes to current practice in this regard.

38. In the period of term extension for patents under 35 U.S.C. § 154(c), how will the issue of willful infringement be handled?

Ans.: 35 U.S.C. § 154(c)(2) limits remedies for the period of term extension. Specifically, the remedies of sections 283, 284 and 285 do not apply to acts as set forth in the cited section.

39. Do extensions for secrecy orders apply to applications that have been "militarily classified" for a substantial amount of time but are not formally under a secrecy order?

Ans.: No. The responsibility for imposing a secrecy order in such a situation lies with the defense agency that classified the application. The contractor/applicant must contact the defense agency directly and request that a secrecy order be imposed in such applications.

Transition Procedure - After Final Practice

1. Does the transitional procedure apply to an application filed after June 8, 1995, which claims the priority of an earlier U.S. application filed prior to that date?

Ans.: No, the transitional procedure is not applicable to any application filed after June 8, 1995. Only applications pending for two years as of June 8, 1995 are eligible for the transition after final practice.

2. Will the transitional after-final practice have any effect on the discretion of the examiner to enter amendments presented after a final Office action that place the application in condition for allowance or in better form for appeal?

Ans.: No, the examiner has discretion to enter such amendments without recourse to the transition practice, so long as the amendments are timely presented.

3. If an information disclosure statement is submitted after final and is not considered by the examiner because it is not accompanied by the appropriate fee and certification, will the statement be considered if the transition after-final fee is paid without any additional fee or certification?

Ans.: Yes. Once the transition after-final fee is paid, any information disclosure statement that is in compliance with 37 CFR 1.98 will be entered and considered by the examiner.

4. What types of submissions can be made under the transitional procedure?

Ans.: A submission may include an information disclosure statement, amendments, new evidence and new arguments.

5. Does the transition after-final practice only apply to situations where an application is under final rejection on June 8, 1995?

Ans.: No, the practice applies to any final rejection before or after June 8, 1995, so long as (1) the application is still pending, (2) the submission sought to be entered was filed prior to or with the notice of appeal, (3) the fee required by proposed rule 1.129(a) can be paid on or after June 8, 1995, and within 1 month of the notice denying entry of the submission and (4) the application is at least 2 years old on June 8, 1995.

6. What happens in transition after-final practice where the Board or a court affirms the rejection of all claims, or where Board reverses all outstanding rejections, but makes a new ground of rejection under 37 CFR 1.196(b)?

Ans.: The transition after final practice does not apply to prosecution after a notice of appeal has been filed.

7. Will the small entity discount be available with respect to the transition after-final practice fee?

Ans.: No.

8. Can the international filing date of a PCT application designating the United States be used to determine whether the application is pending for at least 2 years for the transition after final practice?

Ans.: Yes.

Transition Procedure - Restriction Practice

1. Does the transitional procedure apply to an application filed after June 8, 1995, which claims the priority of an earlier U.S. application filed prior to that date?

Ans.: No, the transitional procedure is not applicable to any application filed after June 8, 1995. Only applications pending for three years as of June 8, 1995 are eligible for the transition restriction practice.

2. Will an applicant be permitted to challenge the propriety of a requirement for restriction in an application to which the transitional procedure applies before paying the additional invention fees?

Ans.: Yes, applicant must either file a petition under 37 CFR 1.181 traversing the restriction requirement or pay the additional invention fee within one month from the date of the notice set forth in proposed 37 CFR 1.129(b)(2).

3. The proposed rule appears to apply to a very small number of applications. What is this provision all about?

Ans.: For restriction requirements made on or after April 8, 1995, in applications having an effective filing date of June 8, 1992 or earlier, an applicant will be able to pay an appropriate fee to have additional independent and distinct inventions retained in a given application. The proposed fee is \$730.00 per additional independent and distinct invention. However, if there is no action in such an application due to applicant's action, e.g. filing a series of continuing applications before an examiner is able to issue an Office action in any one of the series of applications, the normal restriction practice would apply.

4. Is the transitional restriction practice available in a situation in which a restriction requirement was previously made in a four year old application between inventions ABC and D and invention A was elected for prosecution and then a divisional application is filed after April 8, 1995, but before June 8, 1995 and the examiner makes a restriction requirement between inventions BCD?

Ans.: No, the transitional practice is not available because the original requirement for restriction among inventions BCD was given by the examiner before April 8, 1995. If there is a new requirement in that divisional application, which separates D into EFG, then the transition practice would certainly apply to inventions EFG.

5. Is the transition restriction practice fee applicable to each application, or each independent and distinct invention in excess of one that is maintained and examined in each application?

Ans.: The transition restriction practice fee is applicable to each invention.

6. If a restriction requirement, in an application that is eligible for the transition restriction practice, divides an application into more than two inventions, do additional fees have to be paid to have all independent and distinct inventions in excess of one examined in the same application?

Ans.: Yes, the proposed rules call for fees of \$730.00 per each additional independent and distinct invention.

7. Will the examiner credit system change for the above applications?

Ans.: Some accommodation will be made for those applications affected by the transition restriction practice.

8. Will the transition restriction practice apply to election of species requirements?

Ans.: Yes.

9. Will the fees for the transition restriction practice be subject to a small entity reduction?

Ans.: No.

10. Will the transitional restriction practice apply in an application in which an applicant submits new claims and the examiner withdraws them from consideration on the grounds of election by original presentation?

Ans.: No, the transition restriction practice would not apply because the examiner would not have had an opportunity to address the subject matter in the newly presented claims.

20-Year From Filing or 17-Year from Grant Patent Term

1. What is the critical date on which a patent must be in force in order to be entitled to the longer of the 17 or 20-year patent term?

Ans.: June 8, 1995.

2. Does a patent have to be in force, i.e., within original term plus any patent term extension, or only enforceable (17 years plus six year statute of limitations) on the critical date in order to be eligible for the longer of the 17-year or 20-year patent term?

Ans.: The patent must be in force on June 8, 1995.

3. If the 17-year patent term expires before the critical date, will a patent owner still be able to enforce the patent during the 20-year patent term, if that is longer than the 17-year patent term?

Ans.: No. The patent was not in force on the critical date.

4. What are the enforceable rights of a patent owner in any bonus patent term that is obtained as the difference between a 17-year term patent and a 20-year term patent?

Ans.: Remedies are limited with respect to activity that was started before June 8, 1995.

5. Will a patentee be entitled to the difference between a 17-year term and a 20-year term even though the patent is subject to a terminal disclaimer?

Ans.: Yes, to the extent that there is a difference based on the term of the underlying patent on which the terminal disclaimer is based and a difference in the patent term of the patent containing the terminal disclaimer.

6. If a patent expires for failure to pay a maintenance and is expired as of the effective date of the implementing legislation and is thereafter restored by petition, what is the term of the restored patent if 20 years from filing would have been longer than 17 years from grant?

Ans.: The term would automatically be 20 years from filing. 35 U.S.C. § 41(c)(1) states that "[i]f the Commissioner accepts payment of a maintenance fee after the six-month grace period, the patent shall be considered as not having expired at the end of the grace period." Accordingly, the patent would have been in force as of the effective date of the 17/20 provision and the patent would automatically run for the longer of the two options. Note, however, that the intervening rights of § 41(c)(2) would apply and would supersede the limitation on remedies in the 17/20 provision.

7. What is the effect of existing patent term extensions on a patent that gets the longer of 17 or 20 years?

Ans.: The statute is capable of at least three interpretations:

The first interpretation is that the existing extension would simply be added to the longer of 17 or 20-year term.

The second interpretation is that the extension would be added only to the original expiration date of the patent as specified in the statute. The original expiration could be interpreted to be the expiration date of the 17-year patent term.

The third interpretation is that the extension to which the patent owner would be entitled would be the extension in section 156 based on the longer of 17 or 20-year patent term.

The PTO has requested public comment as part of its deliberation on developing an appropriate course of action to be taken in this area.

As an example: Assume a patent has been granted an extension of 500 days, where the 500 days was the difference from the end of the 17 -year patent term and one of the limitations of patent term extension which is that the extension could be for no longer than 14 years from the date the FDA approved the product. Under the first interpretation, the patent owner would be entitled to an extension of 500 days from the longer of the 17 or 20-year patent term. Under the second interpretation, applicant would be entitled to an extension of 500 days from the expiration date of the 17-year patent term, or the expiration date of the 20-year patent term without any extension, whichever was longer. So in this scenario, if the difference between the 17 and 20-year patent term was 300 days, the patent would expire 500 days after the expiration of the 17-year patent term. Finally, under the third interpretation, and again assuming the difference between the 17 and 20-year patent term was 300 days, the patent owner would be entitled to an extension of 200 days, because the longer of the 17 or 20-year patent term is the 20-year patent term but under 156, any extension could not go beyond 14 years after the date FDA approved the product. So the 200 days would be the difference between the original 500 day extension and 300 day difference between the 17 -year patent term and the 20-year patent term. In this case, the expiration date of the extended patent would not change.

8. How does a terminal disclaimer affect the term of a patent that is entitled to the longer of the 17 or 20-year patent term?

Ans.: Assume that there are two patents. The first patent was issued in 18 months and received a 17-year patent term. Under the 17 or 20-year provision, the patent term would essentially be 18.5 years after the original patent date. The second patent B was issued after patent A with a terminal disclaimer that said the terminal portion of the term of this patent is disclaimed beyond the expiration date of patent A. What is the effect on the patent term in patent B? Patent B would be entitled to the difference between the 17 or 20-year patent term for the underlying patent A, which would be 18 months in our example unless patent B would not have been entitled to 18 months based on the difference between the terminally disclaimed 17 year and 20-year patent term as to patent B. Note that there are two limitations here - the term of the underlying patent and the term of the patent containing the TD. The terminal disclaimer that was addressed in this example was linked to the expiration date of the underlying patent A. A different result is possible if the terminal disclaimer was couched in terms disclaiming a terminal portion of the patent beyond a specific date.

9. What is the effect of the 17/20-year patent term provisions on a patent reissued after June 8, 1995?

Ans.: The effect on a reissued patent is based on the effect on the underlying patent since a patent is reissued for the unexpired term of the original patent. The original patent is automatically entitled to the longer of the 17/20-year patent terms and, accordingly, the reissued patent would be reissued for the longer of the 17/20 year patent term.

10. Is there any guidance available on the meaning of "substantial investment" or an "equitable remuneration" as those phrases are used in 35 U.S.C. § 154(c)?

Ans.: No.

11. What is the basis for permitting activities or a substantial investment to be made up to June 8, 1995, to restrict the remedies of a patent owner in the longer of 17/20-year patent term, as opposed to December 8, 1994?

Ans.: All of the term provisions in the implementing legislation are effective as of June 8, 1995. Accordingly, the date for establishing activities to restrict remedies under the 17/20 provision has also been set at June 8, 1995.

12. If a patent expires on June 8, 1995, is it "in force" for the purpose of the 17/20 provision?

Ans.: Yes, the patent expires at midnight on June 8, 1995.

Provisional Applications

1. Is a provisional application a regular national filing for the purpose of the Paris Convention?

Ans.: Yes. Foreign filings must be made within twelve months of the filing date of the provisional application. An applicant must file internationally within one year of filing a provisional application if the provisional application filing date is to be relied on?

2. What are the requirements for obtaining a filing date for a provisional application?

Ans.: The provisional application must be made in the names of the inventors and it must be identified as a provisional application. Further, the specification must comply with the first paragraph of 35 U.S.C. § 112 and any drawing required to understand the invention in accordance with 35 U.S.C. § 113 must be included.

3. What are the requirements for filing a provisional application?

Ans.: A written description of the invention, complying with 35 U.S.C. § 112, first paragraph.;
drawings, complying with 35 U.S.C. § 113;
name(s) of the inventor(s);
the filing fee; and
a cover sheet.

4. What information is required on the cover sheet?

Ans.: The cover sheet must
(1) identify the application as a provisional application;
(2) name the inventors;
(3) title of the invention;
(4) name and registration number of atty./agent, if applicable;
(5) docket number, if applicable; and
(6) correspondence address.

5. What is the fee for a provisional application?

Ans.: The fee for a provisional application is \$150.00 with a 50% reduction to \$75 for a small entity.

6. Does a small entity applicant have to file a small entity statement to pay the small entity filing fee?

Ans.: Yes.

7. Can an applicant file a provisional application in a foreign language?

Ans.: Yes, but the applicant will receive a notice to supply an English language translation insofar as 37 CFR 1.52(d) is applicable to provisional applications.

8. Is any particular format required for a provisional application?

Ans.: No.

9. Can an applicant supply missing parts after the filing date?

Ans.: Yes, but a surcharge of \$50, or \$25 for a small entity, will be charged.

10. Does a provisional application require a claim?

Ans.: No. However, claims may be included in a provisional application.

11. Does a provisional application require an oath or declaration of the inventor?

Ans.: No. However, an oath or declaration may be included in a provisional application.

12. Does a provisional application require a power of attorney?

Ans.: No. However, a power of attorney may be required for access or certified copies.

13. If an applicant does not provide the filing fee for a provisional application, or the provisional application goes abandoned before a second application is filed claiming the benefit of the filing date of the provisional application, will the second application be entitled to claim the benefit of the filing date of the provisional application?

Ans.: No. A provisional application may not be relied on unless the filing fee is paid and the provisional application was pending on the filing date of the second application.

14. Does the description in a provisional application have to comply with the first paragraph of 35 U.S.C. § 112?

Ans.: Yes. An applicant is entitled to the claim for the benefit of a provisional application only to the extent that a later claimed invention is described in the provisional application in the manner required by 35 U.S.C. § 112, first paragraph.

15. Does the best mode have to be described in a provisional application?

Ans.: Yes, for the reasons set forth above.

16. Does the best mode have to be updated as of the filing of a subsequent 35 U.S.C. § 111(a) application?

Ans.: No. However, if the subsequently filed application includes matter not present in the provisional application, the best mode may have to be updated. The situation is considered to be analogous to the filing of a continuation-in-part application. Accordingly, the rationale of Transco Products, Inc. v. Performance Contracting, Inc., 32 U.S.P.Q.2d 1077 (Fed. Cir. 1994), would appear to be applicable. The question of whether the best mode has to be updated is the same when going from one application to another - a provisional application to a § 111(a) application or from one § 111(a) application to another § 111(a) application. Clearly, if the substantive content of the application does not change, there is no requirement to update. If the relationship is one of a C-I-P, there may be a requirement to update.

17. Will a filing date receipt be issued in a provisional application?

Ans.: Yes.

18. Can a patent be issued on a provisional application?

Ans.: A patent can be issued on a subsequently filed § 111(a) application that claims the benefit of a provisional application. The provisional application, itself, cannot mature into a patent.

19. When can an applicant file a provisional application?

Ans.: A provisional application can only be filed on or after June 8, 1995.

20. Can a § 111(a) application filed on or after June 8, 1995, be converted to a provisional application?

Ans.: Yes, a § 111(a) application can be converted to a provisional application so long as the petition to make that conversion is made within one year of the § 111(a) application filing date or prior to payment of the issue fee in that § 111(a) application, whichever event is earlier. A petition fee of \$50, or \$25 for a small entity, must also be submitted.

21. Can an application filed before June 8, 1995, be converted into a provisional application after June 8, 1995?

Ans.: No. No provisional application can have filing date prior to June 8, 1995.

22. If an application is filed that does not contain an indication that a provisional application is intended, how will the application be processed?

Ans.: The application will be processed as a § 111(a) application. However, the unintentionally filed § 111(a) application can be converted to a provisional application without paying the relatively higher § 111(a) filing fees.

23. Why would one want to convert a § 111(a) application into a provisional application?

Ans.: There may be many reasons why one would want to convert a § 111(a) into a provisional application. Two such reasons are: First, you may have made a mistake in not clearly indicating that the application is intended to be a provisional application. If it is not clearly stated that an application is a provisional application, it will be treated as a § 111(a) application. Secondly, you might want to take advantage, particularly for those inventions that are expected to be commercially valuable for a long period of time, of the opportunity to have the first year of pendency of the application not count toward the 20-year patent term. By converting a § 111(a) application to a provisional application, you get the benefit of any examination that was concluded in the first year and the benefit of not having that first year counted toward the 20-year term. The downside is that the actual grant of the patent may be delayed and you will have forfeited at least the difference between the regular application filing fee and the provisional application filing fee.

24. Will a provisional application go through licensing and review?

Ans.: Yes.

25. Will the PTO grant foreign filing licenses based upon the filing of a provisional application?

Ans.: Yes. Since a provisional application is a regular national filing, it starts the Paris Convention year in order to file applications in foreign countries and obtain the benefit for a prior filing date in the U.S.. Because the provisional application will form the basis of foreign filing, they will be screened and foreign filing licenses issued based thereon.

26. If a patent issues on a § 111(a) application claiming the benefit of the filing date of a provisional application, will the filing date of the provisional be the 35 U.S.C. § 102(e) prior art date?

Ans.: Yes, unless the second application is an international application under the PCT, and a national stage application is ultimately filed under 35 U.S.C. § 371, then the § 102(e) date would be the date prescribed in §102(e).

27. Can a provisional application claim the benefit of the filing date of another application?

Ans.: No, a provisional application cannot claim the benefit of an earlier filed application, either domestic or foreign.

28. Will an examiner review the content of a provisional application?

Ans.: An examiner will review the content of a provisional application only in those situations where it is necessary to establish whether an applicant is entitled to the filing date, or the § 102(e) date of a provisional application in a subsequently issued patent. This is analogous to our current continuing practice.

29. Can a provisional application be pending for more than a year?

Ans.: No.

30. What parts of the provisional application will be considered to determine compliance with 35 U.S.C. § 112, first paragraph?

Ans.: The substantive content of the application would be considered, when the issue arises, based on every part that is submitted with the application including the specification and drawings. Even if a claim is submitted with the provisional application, although it is not required, it too would be considered. In this respect, the provisional application is no different than any other parent application.

31. If a provisional application is first-filed, then within one year a § 111(a) application is filed in the U.S., then within the one year of the § 111(a) application a foreign application is filed, can an applicant claim the benefit of § 111(a) application but not the provisional application?

Ans.: No. The Paris Convention (Article 4(C)(4)) prevents an inventor from claiming the benefit of the second application where the first application (the provisional) was pending at the time the second application was filed. Specifically, the Paris Convention provides that "[a] subsequent application concerning the same subject as a previous first application . . . filed in the same country of the Union, shall be considered as the first application, of which the filing date shall be the starting point of the period of priority, if, at the time of filing the subsequent application, the said previous application has been withdrawn, abandoned, or refused, without having been laid open to public inspection and without leaving any rights outstanding, and if it has not yet served as a basis for claiming priority. "

32. Will applicant have to comply with duty of disclosure in a provisional application?

Ans.: No.

33. Will an applicant have to comply with the sequence rules in a provisional application?

Ans.: Yes, except for the requirement to file a computer readable form. A computer readable form will not be required in a provisional application.

34. Will an applicant have to inform the PTO about the filing of a provisional application if the applicant does not intend to rely on its filing date?

Ans.: No. Since the provisional application will not be examined and will contain no action on its merits, the content of the provisional application is for the benefit of the applicant.

35. Are there any formal requirements for the specification and drawings in the provisional application?

Ans.: Not at this time. We want to make this provisional application as simple and easy for inventors to file as possible, and we do not intend to examine these applications except for some very basic requirements. For example, is there a specification? Fee payment? Inventors listed? Clear indication of provisional? Further, the provisional application must be capable of being microfilmed. We may have to rethink this flexibility depending on what types of submissions we receive. But at this point in time we want to maintain maximum flexibility for inventors.

36. Is there a specific format for the provisional application cover sheet?

Ans.: No. The PTO will make a suggested cover sheet available. However, the cover sheet requirements are content, not format, requirements.

37. Will provisional applications become available to the public?

Ans.: By statute, provisional applications are considered abandoned one year after they are filed. Accordingly, they will not, simply as a provisional application, be available to the public. However, in most cases, a second application will be filed making reference to the provisional application so that once a patent issues on the second or subsequent application making reference to the provisional application, the provisional application would be available to the public in the same way that any patent application on which an issued patent is based is now available to the public.

38. What is the 35 U.S.C. § 102(e) prior art date in the following situation? A provisional application is filed and within one year, a PCT international application is filed designating the United States, and then the national stage under 35 U.S.C. § 371 is entered and a patent on the national stage application is obtained.

Ans.: The § 102(e) date is specified in section § 102(e) as the date that you complete the § 371(1), (2), and (4) requirements, that is, the date you complete the national stage requirements. If, on the other hand, instead of entering the national stage under § 371, you file a § 111(a) application before the deadline to enter the national stage and seek the benefit of the international application designating the U.S. and the provisional application, the § 102(e) date would be the filing date of the provisional application to the extent that the subject matter of the § 111(a) application was supported in the provisional application.

39. Will the first § 111(a) application have the same serial number as the provisional application on which it is based?

Ans.: No. We intend to give each provisional application a number with a unique series code, 60, and a six digit serial number. Any § 111(a) application that is filed will have a

different series code, we are currently in the 08 series, followed by a six digit serial number that is independent of any other filed application.

40. Can you use a provisional application for a design patent application?

Ans.: No. Design patents will retain the 14-year patent term from grant and are not affected by the 20-year patent term. Accordingly, provisional applications are not available for design inventions.

41. Can a provisional application be filed before June 8, 1995?

Ans.: No.

42. Will 37 CFR 1.62 File Wrapper Continuation (FWC) practice be available for filing a § 111(a) application based on a provisional application?

Ans.: No. Our proposed rules specifically prohibit the use of 37 CFR 1.62 practice in this situation. We see the rule 62 practice in this situation as a trap for applicants at least until greater familiarity with provisional applications is developed. Consider, for example, an applicant who files a provisional application and then desires to file a rule 62 continuation of that provisional. A secretary presents the attorney with a rule 62 form that is filed on the last day of the one year period and the provisional application does not contain a claim. What has been filed in the PTO? The applicant has a big problem. First there is no filing date for the rule 62 application because there is no claim. Secondly, applicant will have forever lost any benefit of the filing date of the provisional application because there is no copendency possible within twelve months of the provisional application filing date and the second application. The PTO has tried to set up procedures that are simple, user friendly, but also will prevent applicants from making fatal mistakes that cannot be corrected.

43. Can a provisional application that has gone abandoned be revived?

Ans.: Yes, but only if the provisional application has gone abandoned for failure to respond to some Office requirement such as the failure to pay the filing fee. It is not possible to revive a provisional application so that it is considered pending after the one year period measured from its filing date. If an application goes abandoned within the one year period and you file a second application within that one year period not recognizing that the provisional application has gone abandoned, it would be possible to file a petition to revive after the one year period but, if granted, it would revive the provisional application only up to the point in time which is one year from the filing date of the provisional. By statute, the provisional application cannot be considered to be pending after that one year period.

44. Can an amendment be made to a provisional application?

Ans.: No. No amendment or submission can be made in a provisional application unless it is in response to an Office requirement. See proposed rule 1.53(b)(2). The procedure to address adding material to a provisional application would be to file a second provisional application. Note, the second provisional application cannot rely upon the first but a subsequently filed § 111(a) application may rely, separately, on both provisional applications.

45. Can you rely on a plurality of provisional applications in a subsequent filing of a § 111(a) application?

Ans.: Yes. However, you should be careful on how you update the provisional applications, since a claim in the regular application is going to be entitled to the provisional

application filing date only to the extent that the subject matter of the claim is supported in a particular provisional application.

46. Can you combine two § 111(a) applications into a single provisional application by conversion?

No. Converting an application from a § 111(a) application to a provisional does not change its content, only its impact on 20-year term. Secondly, the only way to combine two or more applications (of any kind) is to refile with a new specification which combines the content of the previous applications. If two or more § 111(a) applications are converted to provisional applications, and applicant wants to retain the benefit of the filing date of both applications, then another § 111(a) application would have to be filed within one year of the first now-provisional application making reference to both provisionals, and presumably we would require applicant to delete the reference (if it appeared) in the second now-provisional application to the first now-provisional application because a provisional cannot claim the benefit of any earlier filed application.

47. Can a person filing a provisional application use "patent pending" on a product that is marketed?

Ans.: The provisional application is clearly an application for patent that clearly signifies that the inventor has entered the patent system and has taken a first step to obtaining a patent. However, a provisional application will not be pending after a year from its filing date, so unless the inventor has filed another application, the marking would not be appropriate after a year.

48. Is a drawing required in a provisional application? If one is filed, can the drawing be transferred to § 111(a) application?

Ans.: The value of a provisional application lies in whether it supports a claim in a subsequently filed application. If a drawing is required for that purpose, a drawing would be necessary to obtain the benefit of the filing date of the provisional application. Drawings are not transferred from one application to another.

49. Have I created any problems for my client if I file a second provisional application more than one year after filing a first provisional application, and then obtain a patent on a § 111(a) application that is filed within one year of the second provisional application claiming the benefit of only the second provisional application?

Ans.: No, so long as forever forfeiting your right to rely on the filing date of the first provisional application is not a problem. The provisional application is never published, nor would it be accessible to the public unless it is referred to in an application that does mature into a patent.

50. What is the 35 U.S.C. § 102(e) effect of a granted patent when the inventors in a provisional application differ from those in the § 111(a) application that matured into the patent?

Ans.: According to the terms of 35 U.S.C. § 119(e), a § 111(a) application that relies upon a provisional application must have at least one inventor in common with the inventors named in the provisional application. With that requirement satisfied, the 102(e) effect of the granted patent goes back to the filing date of the provisional application.

51. How do you handle the best mode requirement where the inventors differ between the provisional application and a subsequently filed § 111(a) application that relies on the

provisional application, and, the new inventor has a better mode (e.g., a new best mode at time of filing the § 111(a) application because of new inventor)?

Ans.: Again, according to the terms of 35 U.S.C. § 119(e), a § 111(a) application that relies upon a provisional application must have at least one inventor in common with the inventors named in the provisional application. With that requirement satisfied, the inventor that is new, relative to the inventors named in the provisional application, should disclose the new best mode in the § 111(a) application in order to satisfy the basic requirements of the first paragraph of § 112.

52. What about other “oath” related concerns when inventorship differs between a provisional application and a subsequently filed § 111(a) application, e.g., all inventors understand the content of the § 111(a) application and/or the § 111(b) application.

Ans.: Again, according to the terms of 35 U.S.C. § 119(e), a § 111(a) application that relies upon a provisional application must have at least one inventor in common with the inventors named in the provisional application. With that requirement satisfied, the oath related concerns apply only to the filing of the § 111(a) application. No oath or declaration is required in the provisional application.

53. How should you refer to a provisional application in a subsequently filed § 111(a) application?

Ans.: All provisional applications will be given application numbers, starting with a series code “60,” then a six digit number, e.g., “60/123,456.” This number and the provisional application filing date will serve to identify the provisional application. The reference to the provisional application that is required by § 119(e) can be made in the same manner that references to earlier filed applications are made under § 120.

54. How do you make a proper reference when the § 111(a) application is filed on the same day that you convert an earlier filed § 111(a) application to a provisional application?

Ans.: It would be appropriate to refer to the earlier filed § 111(a) application by its initially assigned application number accompanied by a statement that it has been converted by petition to a provisional application and then update the reference once a provisional application number is assigned to the converted application.

55. What is the 102(e) date in the following filing scenarios:

- (a) Provisional --> PCT ---> Entry of national stage under 371?
- (b) PCT --> PCT --> Entry of national stage under 371?
- (c) Provisional --> PCT --> Filing of 111(a) case by national stage deadline?
- (d) 111(a) --> PCT --> Entry of national stage under 371?

Ans.: In (a), (b) and (d), the 102(e) date is determined by the terms of 102(e) itself. The 102(e) date is the date the requirements of 102(e) are satisfied. In (c), the 102(e) date is the filing date of the provisional application to the extent a basis exists in the provisional application; the PCT application is merely a bridge for the subsequently filed 111(a) application.

56. Will access be provided to a provisional application that is referred to in a published or patented foreign document where the provisional application is not used as a basis for priority in

that foreign document? What if the foreign document does rely upon the provisional application? What about a U.S. patent that refers to but does not rely upon a provisional application?

Ans.: This access issue is controlled by 37 CFR § 1.14. The fact that a provisional application is involved does not require a change in the result of the access inquiry. Access is not granted where a provisional application is simply referenced or where priority is claimed. There will be a different result where the provisional application is referenced in a United States patent.

57. Can a design provisional application be filed?

Ans.: No, the design sections of the statute have been explicitly amended to preclude the filing of provisional applications.

58. Will there be a "Box Provisional?"

Ans.: Yes, the proposed rules would create a "Box Provisional Application." It should be used to file provisional applications and all papers relating to provisional applications.

59. Will a provisional patent applicant be able to manufacture or sell in the provisional year?

Ans.: Yes, subject, of course, to the patent rights of others.

60. Is the grace period measured back from the provisional application filing date or the § 111(a) filing date?

Ans.: The grace period is measured from the provisional application filing date.

61. Are the provisions in the implementing legislation regarding the establishment of a provisional application system required by GATT? If not, why were they adopted?

Ans.: The establishment of a provisional application is not required by GATT. The provisional application has been adopted as a mechanism to provide easy and inexpensive entry into the patent system primarily for domestic applicants. The provisional application is part of our newly adopted domestic priority system. Provisional applications will place domestic applicants on a equal footing with foreigners as far as the measurement of term is concerned because the domestic priority period, like the foreign priority period, is not counted in determining the endpoint of the patent term.

62. Can provisional applications be assigned? If so, does the subsequent § 111(a) application have to be separately assigned?

Ans.: Yes, a provisional application can be assigned. Separate assignments for the provisional and subsequently filed § 111(a) should be submitted if the subsequently filed § 111(a) application includes subject matter not included in the provisional application.

64. Can provisional applications be expressly abandoned?

Ans.: Yes.

65. It appears that the ability to convert a § 111(a) application to a provisional application will provide a good mechanism to make inventorship changes that otherwise would be more involved

in a § 111(a) application, at least for those required changes that are identified within twelve months of the first filing.

Ans.: Inventorship changes, only to the extent that an inventor may be added in a provisional application, will be easier in provisional applications than in § 111(a) applications.

66. What will be the effective date of a SIR if it relies on a provisional application?

Ans.: The SIR can rely on a provisional application but the SIR cannot arise out of a provisional application. The 102(e) effective date of a SIR that relies on a provisional application is the filing date of the provisional application.

67. How can the provisional application be a constructive reduction to practice without claims? Won't such an application be more valuable in an interference with claims?

Ans. The provisional application is a constructive reduction to practice for the inventions disclosed where there are no claims. A subsequently filed § 111(a) application will include claims - it will be those claims that will be used to provoke an interference, not the provisional application. Provisional applications are not subject to 35 U.S.C. § 135 of the statute, the interference section.

68. Can you have a broad provisional application, with several inventions disclosed with the best mode of any one of the disclosed inventions tied to the operation of all aspects in the aggregate and then file several separate § 111(a) applications relying on the provisional not only for the disclosures of the separate inventions but also for the disclosure of the best mode in the aggregate operation of all of the inventions.

Ans.: Yes, you get support for as much as is disclosed in the provisional application.

69. If a provisional application is used as the basis for foreign filing, should one comply with the deposit requirements at the time of filing the provisional?

Ans.: Yes.